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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/911,462	07/25/2001	Hideo Ando	211255US2SDIV	5096

22850 7590 11/16/2005

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EXAMINER

SHIBRU, HELEN

ART UNIT PAPER NUMBER

2616

DATE MAILED: 11/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/911,462

Applicant(s)

ANDO ET AL.

Examiner

HELEN SHIBRU

Art Unit

2616

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 25 July 2001.  
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 30-35 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 30-35 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☒ The drawing(s) filed on 25 July 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☒ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date: \_\_\_\_\_.  
5) ☐ Notice of Informal Patent Application (PTO-152)  
6) ☐ Other: \_\_\_\_\_.

***Information Disclosure Statement***

1. The information disclosure statement filed on 4/27/2005 fails to comply with 37 CFR 1.97(c) because it lacks a statement as specified in 37 CFR 1.97(e). It has been placed in the application file, but the information referred to therein has not been considered. The translation of this IDS must be submitted.

***Double Patenting***

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 30-45 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 30-33 of U.S. division application No. 09/790,814 in view of Kim (US Pat. No. 6,766,103).

4. The subject matter of claim 30 can be found in application 09/790814. Application 09/790814 claim 1 recites an information storage medium comprising:  
an audio recording area configured to store audio information of one or more tunes or one or more pieces of music in a unit of a given track; and  
a management area configured to store management information with respect to the

track of said audio information, said management area including program chain information configured to control a reproduction sequence of said audio information, said program chain information including, cell information having entry point information, said entry point information including information describing a duration of representative audio which may be used to identify the track, and program information different than the cell information and configured to manage the audio information of one or more tunes or one or more pieces of music, wherein said program information further including representative picture information containing entry number information configured to describe an entry number of a still picture object in which a representative picture for the track exists (the recording area of the still picture is inherent).

In the same field of endeavor Kim discloses management area including original program chain information configured to control a reproduction sequence of said audio information in accordance with an order of recording said audio information (see col. 3 lines 29-42, and col. 3 line 63-col. 4 line 3 and 14-33). Kim further discloses user-defined program chain information configured to control another reproduction sequence of audio information, and another reproduction sequence being free of the recording order of said audio information (see col. 3 lines 19-58 and col. 5 line 36-col. 6 line 19). Kim further discloses user-defined program chain information including entry point information configured to indicate one or more entry points of said audio information (see col. 3 line 46-col. 4 line 3 and lines 7-13). Kim further discloses entry point information including track head entry point information configured to manage said one or more tunes or one or more pieces of music (see col. 4 lines 7-33). Therefore it would have been obvious to one skill in the art at the time the invention was made to modify claim 1 of

application 09/790,814 using Kim in order to enable a user to find a desirable audio track easily and quickly among a lot of audio tracks recorded in a high capacity recording medium.

The subject matter of claim 31 can be found in the division application claim 32, and see fig. 1, col. 3 lines 19-45 and col. 4 lines 14-33 of Kim.

The subject matter of claim 32 can be found in the division application claim 33, and see fig. 1, col. 4 line 50-col. 5 line 54 of Kim.

Claims 33 and 34 are method claims corresponding to apparatus claims 31 and 32. Therefore claims 33 and 34 are analyzed and rejected for the same reason as discussed in claims 31 and 32 above.

Claim 35 is structural claim corresponding to claim 30. Therefore claim 35 is analyzed and rejected for the same reason as discussed in claim 30 above.

### ***Conclusion***


4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to HELEN SHIBRU whose telephone number is (571) 272-7329. The examiner can normally be reached on M-F, 8:30AM-5PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, JAMES J. GROODY can be reached on (571) 272-7950. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2616

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Helen Shibru  
November 1, 2005

  
**James J. Groody**  
**Supervisory Patent Examiner**  
**Art Unit ~~262~~ 2616**